

REMARKS

Claims 1-17 have been examined. Claims 1-8 are indicated as being allowed. Claims 9-17 are rejected based on prior art grounds. By this Amendment, Applicant has added claim 18.

I. Rejections based on Prior Art Grounds

A. Claims 9-11 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Weisburn et al. (U.S. Patent No. 5,597,068).

Applicant submits that claim 9 is patentable over the cited reference. For example, claim 9 recites that the dimension of a hinge part is set such that when the cover part is closed and a magnetic tape cassette is stored, a clearance is defined between the cover part and the magnetic tape cassette. Further, in the range of the clearance, there are disposed one or more ribs.

The Examiner maintains that the limitation regarding the storage of a magnetic tape is an intended use, such that the use does not differentiate the claimed apparatus from a prior art apparatus (pg. 2 of the Office Action; Interview Summary mailed on January 9, 2004).

However, the MPEP and the courts make it abundantly clear that functional statements may be included as elements of a claim. For example, the MPEP specifically points out that there is nothing intrinsically wrong in defining something by what it does rather than by what it is. See MPEP §2173.05(g). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” MPEP §2173.05(g) (emphasis added).

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In the present application, the recitation of the magnetic storage cassette set boundaries on the patent protection sought and aids in the determination of the positioning of the claimed clearance and ribs. For example, claim 9 defines the dimension of the hinge part as being sufficient to provide a clearance capable of storing both a magnetic tape cassette and a sheet bundle therein, and additionally, describes one or more ribs being disposed within that clearance. This is not the intended use but, instead, the specific arrangement of the features of the storage case.

In addition, Applicant submits that all of the features of claim 9 are not inherently disclosed by Weisburn. For example, Weisburn fails to disclose the claimed clearance, or the claimed ribs provided in a range of the clearance, as recited in claim 9. As set forth on page 3 of the Office Action, and reaffirmed by the Examiner during the January 8, 2004 Telephone Interview, the Examiner maintains that the jewel box 70 of Weisburn is about the same thickness of a magnetic tape cassette, such that if the jewel box 70 is replaced by a magnetic tape cassette, there would be a clearance between the cover of container 1 and the magnetic tape cassette. However, Applicant submits that the reference fails to teach or suggest that jewel box 70 is about the same thickness of a magnetic tape cassette.

On the contrary, the reference appears to teach away from the Examiner's assertion. For example, the reference discloses that when the jewel box 70 and the holder 55 are removed from panel 12, the container 1 may be used to store other articles such as **video tapes, audio tapes** or video game cartridges (col. 6, lines 2-5). Therefore, it appears that in order for a video tape or audio tape to fit within the container 1, both the jewel box 70 and holder 55 must be removed.

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Thus, Weisburn fails to teach or suggest that the jewel box 70 is about the same thickness as a magnetic tape cassette. Further, the reference fails to teach or suggest that there would be a clearance between the cover of container 1 and a magnetic tape cassette (i.e., if the holder 55 and the jewel box 70 were removed and a magnetic tape cassette was provided in the container 1).

In addition, as noted in MPEP § 2125, “[w]hen the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” *See Hockerson-Halberstadt, Inc. v. Avia Group Int ’l*, 222 F.3d 951, 956 (Fed. Cir. 2000). Accordingly, Applicant submits that the Examiner cannot properly argue that the figures of Weisburn suggest that the jewel box 70 is about the same thickness of a magnetic tape cassette.

Regarding further limitations of claim 9, the Examiner maintains that receptacles 40-43, 46 and 47 disclose the claimed ribs (Fig. 3 of Weisburn; pg. 2 of Office Action). However, the receptacles are formed to hold the holder 55, which stores compact discs (col. 4, lines 35-38). Since the reference discloses that both the holder 55 and the jewel box 70 would need to be removed in order to store an audio or video tape (i.e., col. 6, lines 2-5), it appears that the audio or video tape would cover the receptacles which previously held the holder 55. Therefore, the receptacles would not be disposed in a “clearance” between the magnetic tape cassette and a cover of container 1, as recited in claim 9.

Accordingly, Applicant submits that Weisburn does not inherently disclose all of the features of claim 9, and respectfully requests the Examiner to reconsider and withdraw the rejection.

Since claims 10, 11 and 16 are dependent upon claim 9, Applicant submits that such claims are patentable at least by virtue of their dependency.

B. Claims 9-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Weisburn.

Applicant submits that claims 9-17 are patentable over the cited reference. As set forth above, Weisburn fails to disclose all of the features of claim 9; and accordingly, it would have been necessary to modify Weisburn to arrive at the claimed invention. However, since it is not enough to establish merely that the reference can be modified to arrive at the claimed invention, Applicant submits that the Examiner must show that Weisburn, or the prior art in general, suggests modifying Weisburn to arrive at the claimed invention and in as complete detail as recited in the claims. Applicant submits that the Examiner has not yet established any such suggestion or teaching in Weisburn or the art in general for modifying Weisburn in the manner alleged.

In fact, as mentioned above, Weisburn discloses that the container 1 is not capable of storing a cassette while the holder 55 is mounted in the receptacles 40-43 (see col. 6, lines 2-5). Thus, the container 1 of Weisburn would not be capable of storing a cassette while simultaneously storing a sheet bundle in the receptacles. Accordingly, Weisburn must be modified and some motivation or suggestion must be present for such modification. Since Weisburn does not provide such a motivation, and the Examiner has not established such a motivation, Applicant submits that the present Office Action does not establish the obviousness of claims 9-17 based on Weisburn.

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Amendment under 37 C.F.R. § 1.111
U.S. Application No. 09/980,712

II. Allowable Subject Matter

As noted above, the Examiner has indicated that claims 1-8 contain allowable subject matter.

III. Newly Added Claim

Applicant has added claim 18 to provide more varied protection for the present invention.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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